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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,496	03/21/2001	Donald S. Gardner	42390P10888	8810

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EXAMINER

NGUYEN, TUYEN T

ART UNIT	PAPER NUMBER
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2832

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/813,496

Applicant(s)  
Gardner

Examiner  
Tuyen T. Nguyen

Art Unit  
2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 7, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election without traverse of claims 1-17 [embodiment 1] in Paper No. 9 is acknowledged.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, applicant should clarify the positioning and arrangement of the legs of the second inductor relative to the legs of the first inductor.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section

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- 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).
5. Claims 1, 2, 4-5, 7-9, 11-12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson [US 6,441,715].

Johnson discloses a transformer [figures 5-6] comprising:

- a multi-layer insulating substrate [figures 1c, 3a-3c];
- a first inductor [1000] includes at least one conductive layer;
- a second inductor [2000] includes at least one conductive layer; and
- at least one magnetic layer [400],

wherein the inductors are mounted in trenches [figures 3a-3c].

Regarding claim 2, Johnson discloses each of the inductors including at least one leg.

Regarding claim 4, Johnson discloses the first and second inductors positioned side by side.

Regarding claim 7, Johnson discloses the magnetic layer extending across one or more legs of the first and second inductors.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Fujino et al. [US 6,067,002].

Johnson discloses the magnetic layer being comprised of any magnetic film compatible with semiconductor processing technology [column 2, lines 60-63.]

Johnson discloses the instant claimed invention except for the use of amorphous cobalt alloy for the magnetic layer.

Fujino et al. discloses the use of amorphous cobalt alloy for magnetic layer in an induction device.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use amorphous cobalt alloy for the magnetic layer of Johnson, as suggested by Fujino et al., for the purpose of providing a stable quality circuit substrate.

8. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson.

Johnson discloses the instant claimed invention except for the used of multiple magnetic layers.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use additional magnetic layers in the device of Johnson for the purpose of providing stablization for the device.

9. Claim 3, as best understood in view of the rejection under 112 second paragraph, is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Marty et al. [US 6,031,445].

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Johnson discloses the instant claimed invention except for a portion of a leg of the second inductor being positioned between two legs of the first inductor.

Marty et al. discloses a transformer including first and second inductors, each of which includes a plurality of legs, wherein a portion of the second inductor legs are positioned between the legs of the first inductor [see figure 3].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the leg arrangement of Marty et al. in Johnson for the purpose of reducing size.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tuyen T. Nguyen whose telephone number is (703) 308-0821.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Elvin Enad, can be reached at (703) 308-7619. The fax number for this Group are (703) 308-7722 and (703) 308-7724.

Any inquiry of a general nature or relating to status of this application of proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

TTN *TTN*

June 25, 2003

*Tuyen T. Nguyen*